

REMARKS

By this Amendment, claims 1, 20, 22, 24, and 36 have been amended. Each of the amendments is fully supported by the originally filed application; thus, no new matter has been added by this Amendment.

In the Office Action, claims 1-3, 6, 8, 9, 14, 17, 21, 28-34, 36-42, and 45-48 were rejected under 35 U.S.C. § 112, first and second paragraphs.¹ In addition, claims 1-3, 6, 8, 9, 14, 22, 28-30, 32-34, 36-42, 44, and 48 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. Des. 335,106 to Teeter ("Teeter"); and claims 1-3, 6, 8, 9, 14, 16, 17, 22, 30-34, 36-42, and 45-47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,458,119 to Berenstein et al. ("Berenstein"). Claims 49-59 were identified as containing allowable subject matter.

Applicants thank the Examiner for identifying the allowable subject matter of claims 49-59. In particular, the Examiner stated, among other things, that the prior art "fails to disclose a device that includes a non-loop segment connected to and separating at least two loops." (Office Action, p. 4.) Although Applicants agree with the Examiner's ultimate conclusion that claims 49-59 are patentable, Applicants do not necessarily agree with the Examiner's characterizations. Rather, the pending claims

¹ Applicants note that claim 21 was canceled in the response filed October 7, 2005, and claim 22 is pending yet not rejected under Section 112. Applicants assume that the Examiner meant to apply the rejection to claim 22 and not claim 21. If this understanding is not correct, Applicants request clarification in the next Office Action.

are allowable because the prior art of record fails to suggest or otherwise disclose the various respective combinations present in each of the claims.

Applicants respectfully traverse the rejections under 35 U.S.C. § 112, first and second paragraphs. Each of independent claims 1, 22, and 36 has been amended to delete the "tubular" recitation identified in the Office Action with respect to the Section 112, first paragraph, rejection. Each of these claims has also been amended to delete the "diameter of at least one of the end-pieces being larger than a diameter of a body canal within which a portion of the device is disposed" recitation identified in the Office Action with respect to the Section 112, second paragraph, rejection. Accordingly, each of these rejections is now moot.

Applicants also respectfully traverse the rejection of independent claims 1, 22, and 36 based on Teeter. Each independent claim, as currently amended, requires, among other things, an elongated body portion comprising a substantially cylindrical non-loop segment. As illustrated in at least the embodiments of FIGS. 2-3B of the present application, for example, the non-loop segment may be substantially cylindrical. The amended claim features are supported at least by original FIGS. 2, 3A, and 3B. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1564, 19 U.S.P.Q.2d 1111, 1117 (Fed. Cir. 1991) ("[D]rawings alone *may* be sufficient to provide the 'written description of the invention' required by §112, first paragraph.") (emphasis in original); *Koito Mfg. Co. v. Turn-Key-Tech, LLC*, 381 F.3d 1142, 1154, 72 U.S.P.Q.2d 1190, 1199 (Fed. Cir.

2004) ("[T]he written description requirement can be satisfied by 'words, structures, *figures, diagrams, formulas, etc.*'" (emphasis in original) (holding that claims met the written description requirement where a flow channel was claimed as being "significantly thicker and wider" than an adjacent layer because Figure 1 of the patent clearly showed this feature, even though the specification did not describe this feature with words).

Teeter, however, does not disclose or suggest a substantially cylindrical non-loop segment. Instead, Teeter teaches a garment connector including what appears to be a chain having a center component attached thereto. As illustrated in each of FIGS. 1-7 of Teeter, the center component is not substantially cylindrical, nor does it include any components having a remotely cylindrical shape. Moreover, Teeter is a design patent and, thus, does not include any text characterizing the center component as a substantially cylindrical non-loop segment. Teeter, therefore, does not disclose or suggest, among other things, a substantially cylindrical non-loop segment, as recited in independent claims 1, 22, and 36.

Applicants also respectfully traverse the rejection of claims 1, 22, and 36 based on Berenstein. Each of these claims, as currently amended, requires, among other things, a device having a proximal end-piece and a distal end-piece, a diameter of at least one of the end-pieces being larger than a diameter of a remainder of the device. Support for this amendment can be found throughout the Applicants' specification. For example, at least FIGS. 1, 2, 5A, 5B, 7, and 8 of the application illustrate exemplary

embodiments of the claimed device in which a diameter of at least one of the end-pieces is larger than a diameter of a remainder of the device. See, e.g., *Vas-Cath*, 935 F.2d at 1564, 19 U.S.P.Q.2d at 1117 ("[D]rawings alone *may* be sufficient to provide the 'written description of the invention' required by §112, first paragraph.") (emphasis in original); *Koito Mfg.*, 381 F.3d at 1154, 72 U.S.P.Q.2d at 1199 ("[T]he written description requirement can be satisfied by 'words, structures, *figures, diagrams, formulas, etc.*.'") (emphasis in original) (holding that claims met the written description requirement where a flow channel was claimed as being "significantly thicker and wider" than an adjacent layer because Figure 1 of the patent clearly showed this feature, even though the specification did not describe this feature with words).

Moreover, as discussed in the specification with respect to the exemplary embodiments illustrated in FIGS. 5A and 5B, a "cross-sectional diameter 21 of the proximal piece 20 is greater than the cross-sectional diameter 36 of the body portion 30." (Application, p. 11, ¶ 51.)

Berenstein, however, does not disclose or suggest, among other things, a device having a proximal end-piece and a distal end-piece, a diameter of at least one of the end-pieces being larger than a diameter of a remainder of the device, nor does Berenstein teach a need for such a diameter. Instead, FIGS. 1A-4 of Berenstein illustrate embodiments of the device where the diameter of the end-pieces appears to be substantially the same as the diameter of the coil.

Moreover, no motivation exists to combine the teachings of Berenstein with the teachings of Teeter to obtain Applicants' device, nor is the combination of these two references relied upon by the Examiner to render Applicants' device unpatentable. The garment collector disclosed in Teeter does not constitute analogous art to the embolism devices disclosed in Berenstein. Thus, one of ordinary skill in the embolism devices art would not have looked to the art of garment collectors in developing an embolism device.

Claims 2-12, 14, 15, 17-20, 23, 45, and 48 depend directly or indirectly from independent claim 1; claims 28-34 and 46 depend directly or indirectly from independent claim 22; and claims 37-42 and 47 depend directly or indirectly from independent claim 36. Thus, each of these dependent claims is allowable for at least the same reasons stated above with regard to claims 1, 22, and 36. In addition, each of these dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and, therefore, each is also separately patentable. Though some of these dependent claims have been withdrawn, Applicants request consideration of the withdrawn claims based on the allowability of claims 1, 22, and 36. Applicants also note that withdrawn claims 20 and 24 have been amended to correct typographical errors. No new matter has been added by these amendments.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art cited

Application No.: 10/075,144
New Attorney Docket No.: 09423.0040-00000

against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the final Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

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Dated: June 7, 2006